Chapter 13

Step Six — Patent Maintenance

(how Alex kept rights alive, useful, and worth paying for)

Alex decided that "patent granted" wasn't the finish line; it was the beginning of an ownership project that would last a decade or more. A patent only protects what it claims **and** only while it's **alive**. Step Six was about keeping Alex's patent alive, clean, and valuable—without overspending—and about using the post-grant years to strengthen leverage, adapt to the market, and prune what no longer earned its keep.

This chapter shows exactly what Alex did after allowance: fees, calendars, corrections, reissue and continuation strategy, marking for damages, licensing hygiene, international annuities, and how to use (but not over-trust) AI for monitoring.

First week after allowance: set the table

Alex paid the **issue fee** promptly, then worked a short checklist:

- **Marking plan.** Packaging, datasheets, website "virtual marking" page—ready to go the day the number issued.

- **Sales enablement.** Investor deck and partner materials updated: claim thumbnail + plain-English moat sentence.

- **Continuation(s).** A continuation was already filed to pursue premium-SKU claim angles and factory-method leverage. The parent would issue; the child would keep the fence evolving.

- **Assignment record.** USPTO assignment database reflected the correct owner; any changes since filing were recorded.

(AI)deas — Virtual marking:
List the patent number(s) on a dedicated URL and point packaging to that page. It's easy to keep current and supports pre-notice damages when done correctly.

The three maintenance windows (and the grace period)

U.S. **utility** patents require maintenance fee payments at approximately **3.5, 7.5, and 11.5 years** after the **grant date**. Alex put all three on a dual-reminder docket (internal calendar + counsel's system), with "decision meetings" scheduled **60–90 days** before each due date.

- **Grace period:** If life happens, there's a **six-month** late-payment window with a surcharge. After that, rights **lapse**—and although revival can be possible in certain "unintentional delay" circumstances, Alex never wanted to need that petition.

- **Design patents:** no maintenance fees (good to remember for later design filings).

- **Entity status:** discounts depend on **micro/small/large** status; Alex reviewed status before each payment because investors, licenses, or ownership changes can move the needle.

(AI)deas — Two people, one deadline:
Make one person responsible for paying and a different person responsible for **asking "why"** three months ahead. That's how you avoid mindless autopay **and** avoid blown dates.

Pay or prune? Alex's maintenance decision model

Not every patent deserves 12+ years of fees. Alex used a simple scorecard each window:

1. **Revenue protection:** Does a main product or a negotiated deal **depend** on this claim set?

2. **Deterrence:** Has the patent blocked or deterred competitors (visible design-arounds, "are you open to a license?" calls, etc.)?

3. **Licensing potential:** Are there realistic licensing targets within 12–24 months?

4. **Family leverage:** Does the parent support **continuations** you plan to file or keep alive?

5. **Cost vs. runway:** Will this fee crowd out a **new** filing with better ROI?

If a case didn't clear at least two of those with conviction, Alex considered letting it **lapse**—but only after checking with sales, product, and counsel. Defensive value can be quiet but real.

Keep it enforceable: marking and records

Alex's ops team built a rhythm:

- **Marking audits** quarterly: product pages and packaging matched the claims that actually covered shipped SKUs.

- **Change log** for SKUs: when engineering altered a board or firmware, someone asked, "Do our issued claims still read on this?" If not, the continuation playbook got an entry.

- **Customer and competitor file:** win-loss notes, bids lost because "they have patents," competitor spec sheets—organized by **claim element** for fast charting later.

(AI)deas — Don't over-mark:
Only mark products **actually covered** by at least one issued claim. Over-marking risks legal headaches; under-marking risks damages.

Corrections and fixes: small, medium, and big

Even great filings need cleanup.

- **Certificate of Correction (small):** typos and minor errors that don't change scope. Alex filed these promptly—clean records inspire confidence.

- **Supplemental Examination (medium):** if you realize material prior art wasn't cited, this procedure can have strategic value to address it post-grant. Alex kept it in the toolkit but used it sparingly and with counsel's guidance.

- **Reissue (big):** if an error affected **claim scope** (too narrow, too broad), a **reissue** application can correct it. Alex knew broadening reissue has strict timing and rules; it's powerful but must be planned.

- **Disclaimers:** if a terminal disclaimer or other boundary was wise to clean up double-patenting or align a family, counsel handled it deliberately.

Alex didn't reflexively reissue; the test was: *Will the changed scope pay for itself in negotiations or deterrence within the next 18 months?*

Post-grant challenges: be ready, don't be jumpy

Competitors have tools to attack patents at the USPTO:

- **Ex parte reexamination:** prior patents or printed publications raise a substantial new question of patentability.
- **Inter Partes Review (IPR):** post-grant trial focusing on §102/§103 over patents and printed publications.
- **Post-Grant Review (PGR):** broader grounds, but only for very new patents.

Alex didn't panic about the possibility; Alex prepared:

- **Claim charts** tying **each** element of the issued claims to real product features—kept current.
- **Prior-art map**: the prosecution record's "closest art" summarized in one page; any **new** art monitored with counsel.

- **Continuations**: an active child case provided options to adjust claim scope if the landscape shifted.

(AI)deas — Evidence before adjectives:
If someone attacks, a short, factual **declaration** on the technical mechanism and unexpected behavior can beat a four-page adjective storm. Keep your lab and field data organized by **claim element**.

International reality: annuities and local hygiene

Outside the U.S., most countries require **annual** or scheduled **annuities/renewals** from filing or grant onward. If Alex entered national phase abroad, a docket vendor handled:

- **Annuity calendars by country** and current owner data.
- **Agent instructions** well ahead of due dates.
- **Currency volatility** padding (some offices swing costs with FX).

Alex applied the same **pay or prune** scorecard internationally but with a sharper pencil: if revenue or manufacturing wasn't headed to a jurisdiction, annuities were hard to justify. A narrow set of key markets beat a spray-and-pray portfolio.

Keep the family working: continuations and divisionals

A granted parent doesn't freeze the fence. Alex's continuation plan ran in parallel with maintenance:

- **Market-led continuations:** when pilots showed tighter ripple requirements for premium lighting, a child case targeted the **stricter window** and **alternate hysteresis** flavors.

- **Factory leverage:** a method-of-manufacture continuation covered torque/pressure windows and QA checks—useful for supplier contracts and **customs** actions.

- **Divisionals:** if the examiner had restricted inventions during prosecution, Alex filed divisionals to capture the non-elected choke points.

Funding choices were coordinated with maintenance fees so the **best** filings got priority.

Licensing, enforcement, and quiet leverage

Maintenance only matters if the patent helps the business. Alex built gentle pressure without being litigious:

- **Intro packets** for potential partners: one-page plain-English summary, two annotated figures, claim 1 in readable form, and basic licensing models (field, royalty base, audit terms).

- **Supplier clauses:** warranties against infringement + cooperation in enforcement; optional discounts tied to marking and compliance with factory method claims.
- **Border options:** for imports, counsel explained when **ITC** (trade) remedies or **customs** recordation made sense.

Alex didn't send loud letters; Alex sent **credible** ones when it mattered, backed by clean claim charts and a product that plainly practiced the claims.

Budgets and calendars: nothing fancy, just consistent

Alex's post-grant budget had four predictable buckets each year:

1. **Maintenance/annuities** (known dates).
2. **Continuation/divisional drafting** (tied to roadmap).
3. **Monitoring & light counsel time** (dockets, small corrections).
4. **Evidence development** (keeping test data and field logs current).

Quarterly, the team met for **45 minutes**: check fee calendars, review the competitor file, pick any continuation targets, confirm marking, and approve any corrections. Boring meetings saved expensive emergencies.

AI after grant: use it for radar, not adjudication

Alex used AI as a **radar screen**:

- **Weekly watches** on new U.S. and EP publications in key CPC classes and from known assignees.
- **Clustering** of competitor documents by mechanism (e.g., sampling regimes, thermal stack changes).
- **Drafting** of first-pass claim charts against competitor datasheets.

But Alex **verified** everything. No unreviewed AI output went to a partner or a court, and no confidential documents went into public tools. Enterprise or local models only; human sign-off always.

(AI)deas — Track *mechanisms*, not buzzwords:
Competitors will rename your ideas. Cluster by control flow and placement, not by the adjectives in a brochure.

Ownership and chain-of-title hygiene

A valuable patent with messy ownership is a deal-killer. Alex kept the file clean:

- **Recorded assignments** for any new inventors or transfers.
- **Liens/security interests** (e.g., investor collateral) properly recorded and, later, released.
- **Name changes/mergers** reflected at the USPTO and in foreign offices.

Every year, counsel ran a **portfolio title audit** in one page. During fundraising, diligence moved quickly because the paper trail already existed.

When to let it go (and do it gracefully)

Alex lapsed one smaller case at the second window. Before doing so, Alex:

- Confirmed no **contract** required maintenance (some deals do).
- Checked that no pending **continuation** depended on the fee decision.

- Notified internal stakeholders (sales, ops) and updated the **virtual marking** page the same day.

Letting go funded a better continuation on the flagship family. Discipline beat hoarding.

A compact maintenance checklist Alex ran each quarter

- **Fees & status:** Any U.S. window within 120 days? Any foreign annuities this quarter? Entity status still correct?
- **Marking:** Website/page current; packaging reflects actual covered SKUs.
- **Corrections:** Any typos or minor errors? Prep certificates of correction.
- **Continuations:** Any roadmap change worth a child case? Is the parent still open to file from?
- **Competitors:** Any new datasheet or public demo worth a **claim chart**?
- **Evidence:** Lab results and field logs tied to claim elements, labeled and dated.
- **Title audit:** Assignments and name changes recorded everywhere needed.

- **Budget:** Next two quarters funded; no conflicts with R&D priorities.

Why Step Six mattered to Alex

Paying fees on time kept rights alive. But the real value came from **treating the post-grant years like product operations**: clear calendars, purposeful continuations, clean marking, ready evidence, and selective pressure where it moved deals. Alex's lesson was simple: patents don't defend themselves, and they don't need drama. They need steady maintenance, honest self-assessment, and a plan that links **each dollar** to **fewer, better fences** around the business.

With Step Six complete, Alex had turned an idea into an issued asset—and then into a managed, living moat. Next, the book zooms back out to the broader commercialization play: how provisional vs. non-provisional strategy, patent types, foreign rights, and monetization fit together so you can pick the right filing path for your invention and your market.

Section 3

Must-Know Patent Differences